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EXAMINER

WYSZOMIERSKI, GEORGE P

ART UNIT

PAPER NUMBER

1742

DATE MAILED: 01/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/991,270

Applicant(s)

CHANDLER ET AL.

Examiner

George P Wyszomierski

Art Unit

1742

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 150-227 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 150-173 is/are allowed.
- 6) ☒ Claim(s) 174-227 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 174, 177, 187 and 189 are rejected under 35 U.S.C. 102(b) as being anticipated by Kodas et al. (U. S. Patent 5,421,854).

Kodas discloses a method of forming particles comprising a metal and a metal oxide by forming a solution comprising precursors of the desired components, generating an aerosol of droplets from the solution dispersed in a carrier gas, and heating to a temperature within the range of instant claim 177 to form the metal-metal oxide particles. Thus, Kodas et al. is held to fully disclose all aspects of the presently claimed invention.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 180, 182 and 183 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kodas et al.

Kodas, described supra, does not specify the 90% theoretical density as required by instant claim 180 or the removal of droplets of a given diameter as required by instant claims 182 or 183. These differences are not seen as resulting in a patentable distinction between the prior art and the claimed invention because:

a) Kudas column 7, lines 60 and 68 state that the particles formed in the prior art are "dense". Given that both the starting materials and the process steps of the prior art are substantially identical to those claimed, it is a reasonable assumption that the prior art process (which produces "dense" particles) results in particles having the presently claimed level of density.

b) Kudas column 4, lines 48-49 recognize that a relationship exists between droplet sizes and particle size of the powder. Thus, one of skill in the art, seeking a desired particle size, would be motivated to control the droplet sizes in the prior art. Given that the instant claims do not specify any particular droplet sizes to be removed (merely specifying those "greater than a preselected maximum" and "less than a preselected minimum" in instant claims 182 and 183 respectively) it would have been an obvious expedient to one of ordinary skill in the art to remove droplets of an unwanted size when performing the prior art process.

Consequently, the disclosure of Kudas et al. is held to create a prima facie case of obviousness of the presently claimed invention.

5. Claims 174-227 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 20-53 of U.S. Patent No. 6,165,247. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims are drawn to processes of making alloy, composite, or coated particles generically and/or comprising nickel, whereas the '247 claims are to processes of making particles comprising platinum (with or without other metal or oxide phases). However, note that the process claimed in the '247 patent may result in particles comprising nickel; see '247 claim 49. Note further that the process of the instant claims may result in particles comprising platinum; see instant

claim 206. Finally, note that many of the dependent claims in the present application define limitations substantially the same as those of the '247 patent; compare instant claims 180-183 with '247 claims 24-27, instant claims 195 and 196 to '247 claims 41 and 42, or instant claims 211 *et seq* to '247 claim 53. Given that the actual process steps are the same in both the presently claimed process and that of the '247 claims, no patentable distinction is seen between the two sets of claims.

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. The remainder of the art cited on the attached PTO-892 form is of interest; this art is held to be no more relevant to the claimed invention than the art as applied in the rejections, *supra*.

8. Claims 150-173 are allowable over the prior art of record; the prior art does not disclose or suggest a method of making particles comprising at least 50% nickel by an aerosol heating process.

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Wyszomierski whose telephone number is (571) 272-1252. The examiner can normally be reached on Monday thru Friday from 8:00 a.m. to 4:30 p.m. Eastern time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King, can be reached on (571) 272-1244. Effective October 1, 2003, all patent application related correspondence transmitted by facsimile must be directed to the central facsimile number, (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.



GEORGE WYSZOMIERSKI
PRIMARY EXAMINER

GPW

December 19, 2003